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In re Application of : DECISION ON  
Frank HENGLEIN et al :  
Application No.: 10/584,691 :  
PCT No.: PCT/EP04/14663 :  
Filing Date: 23 December 2004 : PETITION UNDER  
Priority Date: 21 July 2004 :  
Attorney Docket No.: P/746-7 :  
For: METAL PIGMENTS COMPRISING ... :  
COATING AND USE THEREOF : 37 CFR 1.181

This decision is in response to applicants' "PETITION TO SET ASIDE NOTICE OF ABANDONMENT," which is being treated as a petition under 37 CFR 1.181 filed on 30 October 2008, requesting acceptance of a copy of the Declaration submitted as filed in the USPTO on 22 May 2007. Applicants have submitted, *inter alia*, a copy of the 22 May 2007 PTO stamped itemized postcard receipt.

**BACKGROUND**

On 23 June 2006, applicants filed a Transmittal letter for entry into the national stage in the United States Patent and Trademark Office (USPTO), which was accompanied by, the basic national fee. No executed declaration or oath was filed at such time.

On 21 March 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, *inter alia*, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by the International application number and international filing date .. is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68." The notice indicated that the items must be submitted within two months from date of mailing or by 32 months from the priority date of the application, in order to avoid abandonment of the national stage application.

On 26 June 2008, the USPTO mailed applicant Notification of Abandonment (Form PCT/DO/EO/909) indicating that applicant has failed to respond to the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905) mailed 3/21/2007 within the time period set therein.

On 22 August 2008, the USPTO mailed applicant a communication informing applicant that the application was abandoned.

In response to the "NOTICE OF ABANDONMENT" mailed on 26 June 2008 and the communication on 22 August 2008, petitioner submitted on 30 October 2008 the instant petition requesting withdrawal of the "Notice of Abandonment." In support of the request, petitioner has provided a copy of the returned/stamped receipt card acknowledging a receipt date of 22 May 2007. The response is timely with an extension of time of one month because it was after the time period allocated in the Notice.

### DISCUSSION

Petitioner's present petition accompanied by a copy of the following document, filed purportedly with the USPTO as indicated in the stamped postcard:

- (1) Response to Notification of Missing Requirements (Executed Declaration and Power of Attorney)

The postcard lists the above item and bears a USPTO date of stamp as 22 May 2007.

MPEP 503 provides:

A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO.

Petitioner's postcard is accepted as *prima facie* that a Declaration was timely deposited with the U.S. Patent and Trademark Office on 22 May 2007.

Accordingly, the date of receipt for the Declaration is 22 May 2007. Applicants are being charged one month extension fee of \$130.00 to Deposit Account No.: 15-0700 because the executed declaration was received after the two month period allocated in the Notice.

As a result, the Notice of Abandonment (Form PCT/DO/EO/909) mailed on 26 June 2008 was erroneous.

### CONCLUSION

The petition under 37 CFR 1.181 is **GRANTED**.

The NOTICE OF ABANDONMENT mailed on 26 June 2008 has been **VACATED**.

This application is being forwarded to the Office of Patent Application Processing (OPAP) for continue processing.



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